

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 28 2001

SVANBORG et al.

Group Art Unit: 1642

Application No.: 09/555,270

Examiner: M. Wells

Filed: August 30, 2000

For: THERAPEUTIC AGENTS

TECH CENTER 1600/2900

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed is a Response to Restriction Requirement for the above-identified patent application.

- ☒ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and a check for ☐ \$55.00 (248) ☐ \$110.00 (148) to cover the requisite Government fee are also enclosed.
- ☐ Also enclosed is _____
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$355.00 (279) ☐ \$710.00 (179) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted ___, on ___, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least ___, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- ☒ No additional claim fee is required.

(03/01)

☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (103) =	
Independent Claims		MINUS =		× \$80.00 (102) =	
If Amendment adds multiple dependent claims, add \$270.00 (104)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					-0-

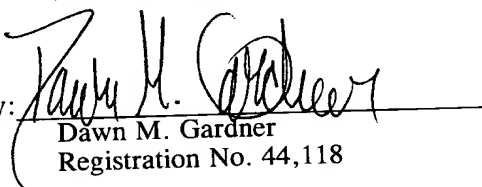
☐ A claim fee in the amount of \$_____ is enclosed.

☐ Charge \$_____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
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Date: June 25, 2001

Applicants hereby elect the Group I invention, directed to claims 1-7 and 14, with traverse.

This election is made *with* traverse. Applicants submit that the Examiner has applied the MPEP § 803 standard of restriction practice to the present application. Applicants contend that it is improper to apply the MPEP § 803 standard of restriction practice to the present application. The present application is an international application in the national stage and has been filed under 35 U.S.C. § 371. Thus, the unity of invention standard of practice should be applied to the present application.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. MPEP § 1893.03(d). If an application contains more than one invention, applicants have the right to include in a single application those inventions which are so linked as to form a single general inventive concept. Further, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The special technical feature is what defines the contribution which each claimed invention, considered as a whole, makes over the prior art. MPEP § 1893.03(d). Applicants submit that the technical feature which forms the special technical relationship among the inventions of the present application is the agent comprising a protein complex.

Several examples, which illustrate the principles of unity of invention, are found in Appendix AI of the MPEP (see the PCT Administrative Instructions, Annex B, Part 2). Examples 1 (at MPEP page AI-42) is particularly relevant to the present application.

Example 1 illustrates that unity exists between a substance and the use of the substance for some purpose. This example corresponds to the relationship between the agent of the claims of Group I and the methods of the claims of Groups I, II and III. Accordingly, the claims of Groups I, II and II should be examined together.

Notwithstanding the above, applicants respectfully submit that, according to the MPEP § 803, a restriction between patentably distinct inventions is proper only where there is a serious burden on the Examiner to examine all the claims in a single application. This is true even when appropriate reasons exist for a restriction requirement.

In the present application, it is believed that because there is a close relationship between the subject matter of the Group I, II and II claims, there would be no serious burden on the Examiner to examine both sets of claims at this time. The claims of Group I relate to an agent comprising a protein complex, and a method of using said agent. The claims of Groups II and III also relate to methods of using said agent. Thus, the methods of Groups I, II and III are linked based upon the agent that each of the methods use. As such, there is a close relationship between the subject matter of these three sets of claims. It is respectfully believed that a search directed to the claims of Group I would include a search directed to the subject matter of the claims of Groups II and III.

In light of the above, withdrawal of the requirement for restriction between Groups I, II and III is respectfully requested. Such action is believed to be in order.

Early and favorable action in the form of a Notice of Allowance is respectfully requested.

In the event that there are any questions relating to this response or the application in general, it would be appreciated if the Examiner would contact the undersigned so that prosecution would be expedited.

Respectfully submitted,

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